

Remarks

Claims 1 and 3-21 are pending in the application, with claims 1, 11 and 21 being the independent claims. Claim 2 has been canceled. Claims 10-21 have been withdrawn from further consideration.

Based on the present Amendment and the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Elections/Restrictions

Concerning the finality of the Restriction Requirement, submitted herewith is a Petition to the Commissioner of Patents from the Requirement for Restriction.

Objection to the Drawings

The Action objects to the drawings for failing to show features of claims 3, 6 and 7. Generally, the cited recitations of these claims deal with manipulation of the pack. The Examiner's attention is respectfully directed to Fig. 1, showing pack P. As such, reconsideration of the objection is respectfully requested.

Rejections under 35 U.S.C. § 112

Claims 5 and 6 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 5 and 6 have been amended to overcome the rejection.

Double Patenting Rejection

Claims 1, 3, 8 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-19, 21 and 22 of copending Application No. 09/986,962. It is noted that claims 17-19, 21 and 22 of copending Application No. 09/986,962 have been canceled, thereby rendering the double patenting rejection moot.

Rejections under 35 U.S.C. § 102

Claims 1-10 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,657,609 to Spada et al. ("Spada").

Claim 1 has been amended with the feature of canceled claim 2, which states " positively guiding each blank along each portion of said path." The Action argues that Spada teaches simultaneously guiding several portions of a blank in the portion of the path 15' (Fig. 3). However, the apparatus in Spada does not positively **guide** the blank. Instead, the apparatus of Spada **transports** the blank on a conveyor belt 15' in a stepwise manner. (col. 4, line 47). On this point, the Action states "the blank is inherently being guided along the path of the conveyor 15' in order to be inserted to the collar in a precise manner."

Concerning the argument that the blank is being inherently guided, attention is respectfully drawn to MPEP §2112, entitled "REQUIREMENTS OF REJECTIONS BASED ON INHERENCY; BURDEN OF PROOF," which states: "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. Ap. & Inter. 1990)." (emphasis in original). MPEP §2112 also states: "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993)." (emphasis in original). In the present case, the Action has neither alleged nor demonstrated that the blank is necessarily guided. Moreover, it is respectfully submitted that the blank is not, in fact, being guided, particularly in the "precise" manner proposed in the Action. The apparatus of Spada is inexact and imprecise because of the slipping of the blanks during stoppage and acceleration of the conveyor belt. It is important to note that the belts transports the blanks in a very fast manner, on the order of 600 blanks per minute.

It is also noted that the Action fails to allege that the blank is guided along each portion of the path, as previously recited in claim 2. Spada also particularly fails to teach this feature.

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Accordingly, Spada fails to disclose the features of claim 1 in that Spada fails to show that the blanks are being guided along each portion of the path. Furthermore, Spada fails to inherently disclose that the blanks are being guided. As such, claim 1 is allowable over Spada.

Claim 21 has been amended in accordance with the amendments to claim 1 and is allowable for the same reasons as claim 1.

All of the stated grounds of objections and rejections have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

A Notice of Allowance is respectfully requested.

Respectfully submitted,



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